UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,282	03/16/2001	Joseph Barilovits	BAR-002PA	6583

7590 10/14/2003

J.M. ROBERTSON INTELLECTUAL PROPERTY
233 SOUTH PINE STREET
SPARTANBURG, SC 29302

EXAMINER	
PURVIS, SUE A	
ART UNIT	PAPER NUMBER
1734	8

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/810,282	BARILOVITS ET AL.	
	Examiner	Art Unit	
	Sue A. Purvis	1734	

-- The MAILING DATE of this communication appears on the cover sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3-8, 10, 12-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Voy et al. (US Patent No. 5,351,426).

The admitted prior art as detailed on pages 1-3 of the specification disclose that it is known to mark locations along the length of web by placing removable labels at those locations. In order to ensure easy removal of the labels from the web, it is known to have a portion of the label be projected outward from the edge of the web, thus permitting that portion to be easily grasped for removal. Furthermore, it is also known to utilize an adhesive pattern across the contact surface of the label such that one free end of the label which corresponds to the outwardly projecting portion be substantially free of adhesive.

The admitted prior art does not disclose adhesive free zones on both sides of the label.

Voy discloses a method and apparatus (10) which can be varied in a multiplicity of ways for the purpose of the manufacture of labels of a particular type and in accordance with the orders placed therefor. The labels (117) include a periphery (106) of the zone of adhesive (105) of each label is recessed from the outer periphery of the labels.

This facilitates dispensing of the labels from the carrier sheet in that it leaves an edge free from adhesive attachment to a carrier sheet which facilitates removal of each label and precise positioning in registry with the product. Voy discloses several embodiments of labels on carrier sheets. Figure 9 shows a carrier sheet (391) wherein zones of adhesive (405) for each of the labels to be manufactured are long narrow strips having peripheries (406) covering an area recessed from the edge (415) of the resulting labels (417). Figure 10 discloses a label with two zones of adhesive (505); the zones have peripheries (506) which are of narrow configuration and recessed from the edges of the labels (517). Figure 11 shows a label (617) with zones of adhesive (605). The peripheries (606) of the zones of adhesive are circular and one is provided for each label to be formed. The peripheries (606) are recessed from the edges of the resulting labels (617). Figure 12 discloses a label (717) with zones of adhesive (705) and peripheries (706) of circular configurations and the zones are spaced from each other but taken together cover an area smaller than the surface of the label (717). (Col. 11, lines 23-33; Col. 19, lines 11-43.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made that in addition to the one adhesive free end in the admitted prior to also include a second adhesive free end as taught by Voy, because Voy teaches the advantages of having label where the edges of the label are adhesive free. The advantage includes minimizing the adhesive contact between the label and the carrier web, thus making it easier for a user to remove the label from the web.

Regarding claims 3, 4, 12 and 13, rectangular labels are known and commonly used as shown in Voy Figure 5.

Regarding claims 5-7 and 14-16, while there is no mention of what percentage of the total surface area is covered by adhesive in the admitted prior art, Voy, it would have been obvious to one having ordinary skill in the art at the time the invention was made to change the amount of adhesive on the label based on the details of the system as discussed in Voy. Details such as the material of the label, material of the web, the type of article to be labeled, and the type of adhesive to be used all need to be considered by the artisan to determine how much adhesive is needed and how much of the surface area of the label is needed to covered. Thus it is within the purview of the artisan to have adhesive zones of 75, 70, and 60 percent of the total surface area of the contact surface.

Regarding claims 8 and 17, page 1 of the instant specification admits using textile fabric is known.

3. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Voy et al. as applied to claims 1 and 10 above, and further in view of Amberkar (US Patent No. 4,166,144).

The admitted prior art in view of Voy does not show a label with a surface that has substantially reflective metallic character.

Amberkar discloses a label stock which has a metallic overcoat (11). (Col. 2, line 18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a metallic coat on the label of the admitted prior art in view of Voy, because labels with a metallic appearance are known and used in the labeling art as shown in Amberkar. Furthermore, it is within the purview of the artisan to choose a

metallic label based on what the artisan wants to use the label for. For example, a metallic label may grab the consumer's attention quicker than a non-metallic label, which would be desirable if the artisan wants to attract attention to the product on which the label is placed.

4. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Voy et al. as applied to claims 1 and 10 above, and further in view of Steidinger (US Patent No. 5,700,536).

The admitted prior art in view of Voy does not show heating the label prior to being attached to the web.

Steidinger discloses an integrated label product where the web (37) with the adhesive patterns applied carries to a station (40) to cure the patterns of adhesive if cold adhesives are used. In the case of hot melt adhesives, curing is not required but it is sometimes desirable to cool the patterns of adhesive in which case station (40) can be used for this purpose. Curing can be by drying, heating, cooling, and by UV or infrared radiation, for example. (Col. 5, lines 28-35).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to heat the web of the admitted prior art in view of Voy once the adhesive is applied but before transferring the label to the carrier web as taught by Steidinger, because curing the adhesive helps in the application of the label to the web. Enabling the label to adhere to the web more completely and it is less likely that labels will fall off the web before they are used.

Response to Arguments

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Voy teaches the advantages of having label where the edges of the label are adhesive free. Voy also teaches that it is possible for an adhesive to stay on the web even if the entire surface of the adhesive is not covered. This is further discussed in Carney, Jr. (US Patent No. 5,665,445) where the advantages of having adhesive on a limited amount of the label surface are discussed. For example, it is easier to remove the label once it was applied. It makes it easier to remove the label without tearing it and prevent damage to the article when the label is removed.

6. The examiner disagrees with applicant's assertion that the combination of the admitted prior art in view of Voy destroys the admitted prior art. The admitted prior art on page 2, lines 17-20 discloses an adhesive free ends with the remaining portion of the label having an adhesive pattern thereon. Voy discloses an adhesive pattern which includes adhesive-free ends as well adhesive-free zones on the inner surface of the label. Furthermore, the labels are subsequently used in a labeling machine where a concern of the skilled artisan is whether the label will remain on the web until it is applied to the article.

7. In response to applicant's argument that Voy is not suitable for placement on a moving web, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Voy teaches having labels on a web with adhesive-free zones, it is within the purview of the artisan to look to the teachings of Voy when modifying the admitted prior art.

8. The teaching in Voy that patterned adhesive makes it easier to remove the label from the backing does not go so far to say that patterned adhesive would make it more likely that the label would fall off the backing as feared by the Egan Declaration. Voy shows that it is possible to have less adhesive and still retain the label on the web.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (703) 305-0507. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on (703) 308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1495.

Sue A. Purvis
Examiner
Art Unit 1734

sp
October 5, 2003

RICHARD CRISPINO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700